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Legal Staff
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Send to: Rafael Bacares PCT Legal Examiner Office of Legal Administration	From: Mariana Paula Noli
Company: USPTO	Date: May 30, 2006
Fax Number: (571) 273-0459	Phone No.: (818) 488-8143

- ☐ Urgent
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- ☐ Please comment
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- ☐ For your information

Total pages, including cover: 18

Comments:

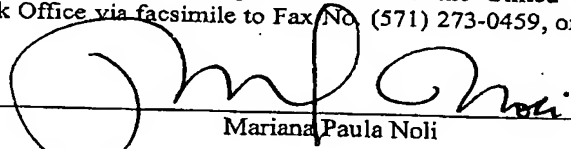
Applicant: SiRF Technology, Inc.
Title: "GENERIC SATELLITE POSITIONING SYSTEM RECEIVERS WITH PROGRAMMABLE INPUTS AND SELECTABLE INPUTS AND OUTPUTS"
Application No.: 10/518,621
Attorney Docket Number: ST02017USU3 (141-US-U3)

Please acknowledge receipt of the following documents:

- 1) Renewed Petition Under 37 CFR 1.47(a) (3 pages);
- 2) Copy of the Decision on Petition under 37 CFR 1.47(a) mailed January 27, 2006 (4 pages);
- 3) Declaration of Mariana Paula Noli (3 pages);
- 4) Exhibits A, B, C, and D (4 pages);
- 5) Form PTO/SB/22 Petition for Extension of Time under 37 CFR 1.136(a) (1 page + copy); and
- 6) Credit Card Authorization in the amount of \$ 225.00 (1 page).

Certificate of Transmission

I hereby certify that this document (along with any papers referenced as being attached or enclosed) is being transmitted to the United States Patent and Trademark Office via facsimile to Fax No. (571) 273-0459, on the date set forth above.


Mariana Paula Noli

BEST AVAILABLE COPY

PATENT
Docket No.: ST02017USU3(141-US-U3)
10/518,621

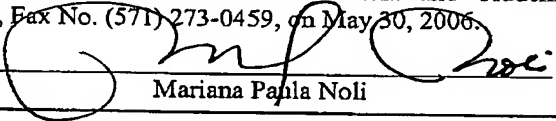
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Orler et al. DOCKET NO.: ST02017USU3(141-US-U3)
SERIAL NO.: 10/518,621 GROUP ART UNIT: Not Yet Assigned
DATE FILED: June 18, 2003 EXAMINER: Not Yet Assigned
CONFIRMATION NO.: 7307

TITLE: GENERIC SATELLITE POSITIONING SYSTEM RECEIVERS WITH
PROGRAMMABLE INPUTS AND SELECTABLE INPUTS AND
OUTPUTS

Certificate of Transmission

I hereby certify that this document (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-0459, on May 30, 2006.


Mariana Paula Noli

May 30, 2006

Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

RENEWED PETITION UNDER 37 CFR § 1.47(a)

This Renewed Petition is submitted in response to the Decision on Petition Under 37 CFR 1.47(a) mailed January 27, 2006, a copy of which is submitted herewith, and for which a request for reconsideration, if desired, may be filed within two (2) months from the mail date of said Decision on Petition. A Petition for a Two-Month Extension of Time extending the time to reply to May 27, 2006, and the appropriate fee are being submitted with this Renewed Petition. Because May 27, 2006, falls on a Saturday, and

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the next succeeding business day is May 30, 2006 (Monday, May 29, 2006, being a Federal holiday, Memorial Day), the present Renewed Petition is believed to have been timely filed under MPEP 710.05.

Said Decision on Petition states, in part, that "it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor." Accordingly, Applicants have, on May 12, 2006, sent a copy of the application filed 20 December 2004 as PCT No. PCT/US2003/019363 to Keith Jacob Brodie at his last known address by Certified Mail, Return Receipt Requested, as evidenced by the Declaration of Mariana Paula Noli submitted herewith. Subsequently, an e-mail was received from Keith Jacob Brodie on May 19, 2006, a copy of which is attached to said Declaration of Mariana Paula Noli as Exhibit, confirming receipt of a copy of said application.

This Renewed Petition and the accompanying Declaration supplements the Declaration of Francisco A. Rubio-Campos submitted with a Transmittal of Missing Requirements filed 25 October 2005, and evidences receipt of the PCT Application No. PCT/US2003/019363 filed 18 June 2003 by the nonsigning inventor, Keith Jacob Brodie, and his refusal to sign the Declaration and Power of Attorney as requested.

Based on the foregoing, the undersigned requests that Keith Jacob Brodie be deemed a joint inventor who has refused to join in an application for patent and that the submitted Combined Declaration and Power of Attorney executed by Anthony James

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Orler and Charles P. Norman be accepted as a Declaration signed by all inventors
pursuant to 35 U.S.C. §118 and Title 37, Code of Federal Regulations, §1.47(a).

Respectfully submitted,
Anthony James Orler et al.

Dated: May 30, 2006

By: Jeffrey C. Will

Jeffrey C. Will

Registration No. 42,227

Phone: (818) 488-8148

Fax: (814) 332-4205

The Eclipse Group
26895 Aliso Creek Road, Suite B-104
Aliso Viejo, CA 92656-5301



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Jennifer H. Hamilton
THE ECLIPSE GROUP
10453 Raintree Lane,
Northridge, CA 91326

27 JAN 2006

In re Application of
Orler et al
PCT No.: PCT/US2003/019363
Application No: 10/518,621
Int. Filing Date: 18 June 2003
Priority Date: 20 June 2002
Attorney's Docket No.: ST02017USU3 (141-US-U3)
For: GENERIC SATELLITE POSITIONING ...
SELECTABLE INPUTS AND OUTPUTS

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is in response to the "Declaration of Francisco A. Rubio-Campos" filed on 25 October 2005, which is being treated as a petition under 37 CFR 1.47(a). The petition fee of \$200.00 has been charged to Deposit Account Number 502542 as stipulated in the petition transmitter letter.

BACKGROUND

On 18 June 2003, petitioner filed international application PCT/US2003/019363, which claimed priority to an earlier application filed 20 June 2002. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 20 December 2004.

On 20 December 2004, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 05 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date. The notification stated that the current oath or declaration, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date, and that a \$65 surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required."

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On 25 October 2005, petitioner filed the present petition, a declaration by Francisco A. Rubio-Campos in support of filing on behalf of omitted inventor Keith Jacob Brodie accompanied, inter alia, an executed Declaration without the signature of Keith Jacob Brodie.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part

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of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) and (3) - (4) of 37 CFR 1.47(a) but not requirement (2).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(g).

Regarding requirement (2), Mr. Rubio-Campos' declaration states that on or about August 19, 2005, the firm sent an e-mail to inventor Keith Jacob Brodie that he sign and return the Combined Declaration and Power of Attorney, and that his response was that he would sign the documents once he received the money.

However, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. It is unclear what documents were forwarded to Mr. Brodie because Mr. Rubi-Campos' statement only discusses the declaration and does not refer to a copy of the application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP. 409.03(d) being sent to him. In addition, no documentary evidence to support this assertion has been provided such as a registered returned envelope, a certified mail return receipt, etc..., to show that the letters were sent to Mr. Brodie or the e-mail response by Brodie. Consequently, it is unclear if he actually received the documents.

Moreover, it is not clear from the petition that it was Mr. Rubio-Campos who performed the items listed in paragraph 5 of his declaration, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Rubio-Campos was not the person who performed the actions listed in paragraph 5, petitioner will need to submit statements, with specific facts on the actions referred to by paragraph 5 by person(s) who has first-hand knowledge of such facts.

Accordingly, the steps enumerated by Mr. Rubio-Campos are not sufficient to establish that Mr. Brodie has refused to sign the declaration.

Regarding requirement (3), although petitioner has provided a statement of the last known address of the missing inventor.

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Regarding requirement (4), petitioner has provided an executed declaration signed by Mr. Orlor, and Mr. Norman on their behalf and on the behalf of the nonsigning joint inventor Keith Jacob Brodie.

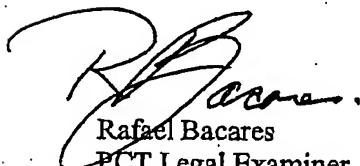
Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

PATENT
Docket No.: ST02017USU3(141-US-U3)
10/518,621

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Orler et al. DOCKET NO.: ST02017USU3(141-US-U3)
SERIAL NO.: 10/518,621 GROUP ART UNIT: Not Yet Assigned
DATE FILED: June 18, 2003 EXAMINER: Not Yet Assigned
CONFIRMATION NO.: 7307

TITLE: GENERIC SATELLITE POSITIONING SYSTEM RECEIVERS WITH
PROGRAMMABLE INPUTS AND SELECTABLE INPUTS AND
OUTPUTS

Certificate of Transmission

I hereby certify that this document (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-0459, on May 30, 2006.

May 30, 2006


Mariana Paula Noli

DECLARATION OF MARIANA PAULA NOLI

Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, MARIANA PAULA NOLI, submit this declaration in support of the Renewed Petition under 37 CFR § 1.47(a) filed concurrently herewith.

1. I am an Intellectual Property paralegal employed by The Eclipse Group, an intellectual property law firm.
2. Our firm has been engaged by SiRF Technology, Inc., 148 E. Brokaw Road, San Jose, CA 95112, to file and prosecute a patent application for an invention

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Docket No.: ST02017USU3(141-US-U3)
10/518,621

disclosed by inventors Anthony James Orlor, Keith Jacob Brodie, and Charles P. Norman.

3. Accordingly, International Application No. PCT/US03/019363 was filed June 18, 2003, for the disclosed invention titled "Generic Satellite Positioning System Receivers with Programmable Inputs and Selectable Inputs and Outputs."

4. Subsequently, a National Stage filing in the U. S. was made on December 20, 2004, being the present case, Application Serial No. 10/518,621.

5. On or about August 19, 2005, I forwarded to Keith Brodie's attention electronic copies of the formal documents by e-mail for his signature. In reply to this request, he asked for a check for \$1,000.00 (a true and correct copy of his e-mail is hereto attached as Exhibit A).

6. On or about May 12, 2006, I caused to be mailed to Keith Jacob Brodie at his last known address, 12 Silveroak, Irvine, CA 92620, a copy of International Application No. PCT/US03/019363 filed June 18, 2003, together with a copy of a Declaration and Power of Attorney and an Assignment, by U.S. Postal Service Certified Mail, Return Receipt Requested (a true and correct copy of the transmittal letter accompanying this mailing is attached here to as Exhibit B).

7. Subsequently, on or about May 15, 2006, we received the domestic return receipt signed by Keith Brodie (a true and correct copy of this return receipt is hereto attached as Exhibit C).

PATENT
Docket No.: ST02017USU3(141-US-U3)
10/518,621

8. On May 19, 2006, our firm received an e-mail from inventor Keith Jacob Brodie stating that his fee for reviewing documents and signing the Declaration and Power of Attorney was \$1,000.00, and that he would start reviewing the documents as soon as he receives a check in this amount (a true and correct copy of this e-mail is attached hereto as Exhibit D).

Respectfully submitted,

Dated: May 30, 2006

By: 

Mariana Paula Noli

Phone: (818) 488-8143

Fax: (818) 332-4205

The Eclipse Group
10605 Balboa Blvd., Suite 300
Granada Hills, CA 91344

EXHIBIT A

Page 1 of 2

From: Keith Brodie [keith.brodie@alum.mit.edu]
Sent: Friday, August 19, 2005 8:04 PM
To: Mariana Noli; Keith Brodie
Subject: Re: SiRF No. 141-US-U3; EG No. ST02017USU3 - Formal Documents for your Signature

Follow Up Flag: Follow up
Flag Status: Completed
Mariana,

I'll be happy to. My fee for this is \$1000.00, please make payable to:

Keith Brodie
12 Silveroak
Irvine, CA. 92620

I'll return the signed documents as soon as I get the check.

Best Regards
Keith

Mariana Noli wrote:

Gentlemen-

Attached are copies of a combined Declaration and Power of Attorney and a Confirmatory Assignment to be signed by you for the above-referenced patent application for "Generic Satellite Positioning System Receivers with Programmable Inputs and Selectable Inputs and Outputs." Please sign these documents and either fax them (to the number below) or e-mail a signed copy back to us as soon as possible. Please mail the executed originals to my attention to the address below. I will certainly appreciate if you could send these documents at your earliest convenience.

Please do not hesitate to contact me if you have any questions or comments regarding this particular matter.

Best Regards,
Mariana Paula Noli
Legal Assistant
The Eclipse Group
10453 Raintree Lane
Northridge, CA 91326
(818) 885-1685 Phone
(818) 332-4205 Fax
mpn@eclipsegrp.com

avast! Antivirus: Inbound message clean.
Virus Database (VPS): 0533-4, 08/19/2005
Tested on: 8/19/2005 7:59:35 PM
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<http://www.avast.com>

EXHIBIT B

Mariana Paula Noli
mpn@eclipsegrp.com

10605 Balboa Blvd., Suite 300
Granada Hills, CA 91344
(818) 488-8143 Telephone
(818) 332-4205 Facsimile



THE ECLIPSE GROUP

AN INTELLECTUAL PROPERTY LAW FIRM

CHICAGO, IL

DURHAM, NC

LOS ANGELES, CA

ORANGE COUNTY, CA

May 12, 2006

VIA CERTIFIED MAILRETURN RECEIPT REQUESTED

Keith Jacob Brodie
12 Silveroak
Irvine, CA 9260

Re: Title "GENERIC SATELLITE SYSTEM RECEIVERS WITH
PROGRAMMABLE INPUTS AND SELECTABLES INPUTS AND
OUTPUTS"
The Eclipse Group Ref. No. ST02017USU3 (141-US-U3)

Subject: Signature of Formal Documents

Dear Keith:

Please find enclosed with this letter the combined Declaration and Power of Attorney and Assignment document for your signature to be filed with the USPTO in the above referenced case.

I have also enclosed for your reference a complete copy of the application as originally filed which includes the specification, claims, abstract and drawings.

Thank you in advance for your time and assistance with this particular matter. As always, do not hesitate to contact me if you had any questions.

Sincerely,
THE ECLIPSE GROUP

Mariana Paula Noli

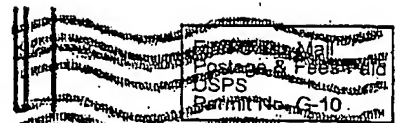
Enclosures

EXHIBIT C

UNITED STATES POSTAL SERVICE

SANTA ANA CA 92701

15 MAY 2006 PM 10 T



- Sender: Please print your name, address, and ZIP+4 in this box

Mariana Paula Noli
 The Eclipse Group LLP
 10605 Balboa Blvd. Suite 300
 Granada Hills, CA 91344

SENDER: COMPLETE THIS SECTION

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

Keith Jacob Brodie
 12 Silveroak
 Irvine, CA 92620

COMPLETE THIS SECTION ON DELIVERY

A. Signature

X

B. Received by (Printed Name)

- D. Is delivery address different from item 1? ☐ Yes
 If YES, enter delivery address below ☐ No

3. Service Type

- ☒ Certified Mail ☐ Express Mail
☐ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.

4. Restricted Delivery? (Extra Fee)

☐ Yes

2. Article Number

(Transfer from service label)

7005 3110 0001 8979 2957

EXHIBIT D

Jeffrey Wilk

From: Mariana Noli
Sent: Monday, May 22, 2006 10:36 AM
To: Jeffrey Wilk; Francisco Rubio-Campos
Cc: Jennifer Hamilton
Subject: FW: Eclipse Group ST02017USU3

Importance: High

Please see below. Thank you.

Mariana Paula Noli
The Eclipse Group
10605 Balboa Blvd., Suite 300
Granada Hills, CA 91344
Phone. (818) 488-8143
Fax. (818) 332-4205

-----Original Message-----

From: Keith Brodie [mailto:keith.brodie@alum.mit.edu]
Sent: Friday, May 19, 2006 10:07 PM
To: Mariana Noli
Cc: Keith Brodie
Subject: Eclipse Group ST02017USU3

Dear Mariana,

I received your letter requesting my Declaration and Power of Attorney with respect to application 10/518,621. This is not the original application filed while I was an employee of SiRF. If it were, my original oath would be all that was required. This application is new, therefore, in some respect - perhaps as a continuation in part.

I cannot therefore, assume, that the specification describes my invention, or that I am the inventor of the claims as written today. To do so will require that I spend considerable time reviewing the document. I am quite busy, and I cannot give this time away for free.

I will be happy to review the documents you sent, and sign the oath if - in fact - it is true that I am an inventor of one or more of these claims. The fee for my time is \$1000.00. I'll start immediately upon receiving the check.

Best Regards
Keith Brodie
12 Silveroak
Irvine, CA. 92620

PTO-2038 (02-2000)

Approved for use through 01/31/2003. OMB 0651-0043

United States Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Credit Card Billing Address**Street Address 1:** 10453 Raintree Lane**Street Address 2:****City:** Northridge**State:** California**Zip/Postal Code :** 91326**Country:** United States**Daytime Phone #:** 818.831.9431**Fax #:** 818.332.4205**Request and Payment Information****Description of Request and Payment Information:****Renewed Petition under 37 CFR 1.47 - Two-Month Extension of**

Patent Fee	Patent Maintenance Fee	Trademark Fee	Other Fee
Application No. 10/518,621	Application No.	Serial No.	IDON Customer No.
Patent No.	Patent No.	Registration No.	
Attorney Docket No. ST02017USU3 (141-US-U3)		Identify or Describe Mark	

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